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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/387,513

09/01/1999

KIYOSHI TOYODA

P18445.P04

2687

7055

7590

08/20/2004

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EXAMINER

PARK, CHAN S

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/387,513

Applicant(s)

TOYODA, KIYOSHI

Examiner

CHAN S PARK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-26 is/are rejected.
- 7) ☒ Claim(s) 19 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 6/3/04, and has been entered and made of record. Currently, **claims 13-26** are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 13-26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 19 is objected to because of the following informalities: perhaps the first line should be replaced with "the image communication apparatus according to claim 13,". Appropriate correction is required.
4. Claim 22 is objected to because of the following informalities: perhaps the first line should be replaced with "the server apparatus according to claim 16,". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnishi et al. U.S. Patent No. 5,655,152 (hereinafter Ohnishi) in view of Toyoda et al. Japanese Patent Publication No. 09-116728 (hereinafter Toyoda).

5. With respect to claim 13, Ohnishi discloses an image communication apparatus (facsimile 24) connected with a receiving facsimile (one of unillustrated output units connected to the server 31 or one of unillustrated facsimile other than facsimile 24 connected to the server 30) via a server apparatus (server 30) on the network (fig. 21), the image communication apparatus comprising:

a communicator configured to communicate with a first server apparatus (30) and with a second server apparatus (31) via the network (col. 27, lines 42-48);

a controller configured to access the first server apparatus to obtain receiving facsimile unit information or capabilities (resolution information of a facsimile other than facsimile 24 connected to the server 30 in fig. 21 and refer to figs. 44 & 45),

the controller being further configured, when the first server apparatus is determined not to store the receiving facsimile unit information, to obtain the information from the second server apparatus (col. 44, lines 36-57 & col. 46, lines 35-43).

Ohnishi clearly teaches that the first server sends information request to other servers to retrieve the information of the destination output units (facsimiles) connected to the other servers.

It should be noted that the Examiner refers fig. 21 to provide a better description of the Ohnishi twelfth embodiment.

According to fig. 21, a bidirectional communication arrow is shown between the server 30 and the facsimile 24. Although the detailed description of the embodiment does not explicitly disclose a communicator in the facsimile 24, it is inherent that an I/O port device or a communicator is included for data transmission between the two devices.

However, Ohnishi does not disclose expressly if the network can be the Internet and if the controller is configured to transform image data, based on the obtained receiving facsimile unit information or capabilities regarding facsimile data that the receiving facsimile can receive, to convert the transformed image data into data for Internet transmission, and to transmit the converted data to the receiving facsimile.

Toyoda, on the other hand, discloses an image communication apparatus connected with a receiving facsimile via a server apparatus on the **Internet** (paragraph 12) wherein a controller is configured to obtain capabilities regarding facsimile data that the receiving facsimile can receive, to transform image data, based on the obtained receiving facsimile unit information or capabilities regarding facsimile data that the receiving facsimile can receive, to convert the transformed image data into data for Internet transmission (E-mail), and to transmit the converted data to the receiving facsimile (paragraphs 19 and 20).

Ohnishi and Toyoda are analogous art because they are from the same field of endeavor, which is the network facsimile art.

Since it was the Ohnishi objective to provide a server to collect information of output units over the network and Toyoda teaches the method of obtaining the

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capabilities regarding facsimile data that the receiving facsimile can receive and the method of transforming image data based on the obtained capabilities regarding facsimile data that the receiving facsimile can receive, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Toyoda system of transforming the image data with the network facsimile of Ohnishi.

The motivation for doing so would have been to inform the transmitting facsimile with the capabilities information of the receiving facsimile in advance so that the transmitting facsimile transmits proper transformed image data to the receiving facsimile that the receiving facsimile can receive in the Internet network.

Therefore, it would have been obvious to combine Ohnishi with Toyoda to obtain the invention as specified in claims 13.

6. With respect to claim 14, Ohnishi discloses the image communication apparatus according to claim 13, wherein the first server apparatus is a local server apparatus in a local area network containing the image communication apparatus, and the second server apparatus is a global server apparatus in a global area network connected with the local area network (fig. 21). According to the Ohnishi, the servers 30, 31, and 32 can be read as both a local and global servers since they all communicate with local output units as well as with other servers. It should be noted that the Office interprets the server 30 as a local server apparatus since it controls the local output units (printer 22 and facsimile 24) and the server 31 as a global server apparatus in a global network since it communicates with other servers for the information exchange (col. 27, lines 42-49).

Furthermore, Toyoda discloses the facsimile device connected over the Internet and LAN. It is well known to one of ordinary skill in the art at the time of the invention that an E-mail transmission can be done over LAN and global area network. Also, refer to fig. 12.

7. With respect to claim 15, Toyoda discloses the facsimile communication using email address (fig. 12). Referring to fig. 12, it would have been obvious to one of ordinary skill in the art to recognize that servers are generally required in the email transmission over the Internet network. Since a DNS server uses the method of transmitting a fax message in a standard email format, the Office interprets the second server as the DNS server for storing the capabilities in the combined invention of Ohnishi and Toyoda.

8. With respect to claim 16, Ohnishi discloses a server apparatus (server 30) connected with a transmitting facsimile (facsimile 24) and a receiving facsimile (one of unillustrated output units connected to the server 31) via the network, the server apparatus comprising:

- a memory (data-output condition storage unit 56) configured to store capabilities regarding facsimile data that the receiving facsimile can receive (figs. 45(a & b));

- a controller configured to obtain the capabilities of the receiving facsimile from another server apparatus that stores the capabilities of the receiving facsimile, when the capabilities of the receiving facsimile are not stored and when the transmitting facsimile inquires regarding the capabilities of the receiving facsimile (col. 44, lines 36-57 & col. 46, lines 35-43).

Ohnishi teaches that the first server sends information request to other servers to retrieve the information of the destination output units (facsimiles) connected to the latter servers.

It should be noted that the Examiner refers fig. 21 to provide a better description of the Ohnishi twelfth embodiment.

However, Ohnishi does not disclose expressly if the network can be the Internet and if the controller is configured to transmit the capabilities of the receiving facsimile to the transmitting facsimile whereby the transmitting facsimile is able to transform image data, based on the obtained capabilities of the receiving facsimile, to convert the transformed image data into data for Internet transmission, and to transmit the converted data to the receiving facsimile.

Toyoda, on the other hand, discloses an image communication apparatus connected with a receiving facsimile via a server apparatus on the **Internet** (paragraph 12) wherein a controller is configured to transmit the capabilities of the receiving facsimile to the transmitting facsimile whereby the transmitting facsimile is able to transform image data, based on the obtained capabilities of the receiving facsimile, to convert the transformed image data into data for Internet transmission (E-mail), and to transmit the converted data to the receiving facsimile (paragraphs 19 and 20).

Ohnishi and Toyoda are analogous art because they are from the same field of endeavor, which is the network facsimile art.

Since it was the Ohnishi objective to provide a server to collect information of output units over the network and Toyoda teaches the method of obtaining the

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capabilities regarding facsimile data that the receiving facsimile can receive and the method of transforming image data based on the obtained capabilities regarding facsimile data that the receiving facsimile can receive, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Toyoda system of transforming the image data with the network facsimile of Ohnishi.

The motivation for doing so would have been to inform the transmitting facsimile with the capabilities information of the receiving facsimile in advance so that the transmitting facsimile transmits proper transformed image data to the receiving facsimile that the receiving facsimile can receive in the Internet network.

Therefore, it would have been obvious to combine Ohnishi with Toyoda to obtain the invention as specified in claims 16.

9. With respect to claim 17, the combination of Ohnishi and Toyoda discloses the server apparatus according to claim 16, wherein Ohnishi further discloses that the controller obtains the capabilities of the receiving facsimile from a further server apparatus, when the another server apparatus does not store the capabilities of the receiving facsimile (col. 46, lines 35-43). Note that Ohnishi discloses the method of broadcasting the information request. The method, therefore, obtains the capabilities of the receiving facsimile from another server apparatus, when the second server apparatus does not store the capabilities of the receiving facsimile.

10. With respect to claim 18, Ohnishi discloses a capability exchanging method for controlling an image communication apparatus (facsimile 24) connected with a first server apparatus (server 30) and a second server apparatus (server 31) via the network

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(fig. 21), at least one of the first server apparatus and the second server apparatus storing capabilities regarding facsimile data that a receiving facsimile (one of unillustrated output units connected to the server 31 or one of unillustrated facsimile other than facsimile 24 connected to the server 30) is capable of receiving (col. 44, lines 36-57 & col. 46, lines 35-43), the capability exchanging method comprising:

accessing the first server apparatus (30) to obtain capabilities regarding facsimile data that the receiving facsimile is capable of receiving (resolution information of a facsimile other than facsimile 24 connected to the server 30 in fig. 21 and refer to figs. 44 & 45);

obtaining, from the second server apparatus, capabilities regarding facsimile data that the receiving facsimile is capable of receiving, when the first server apparatus is determined not to store the capabilities regarding facsimile data that the receiving facsimile is capable of receiving (col. 44, lines 36-57 & col. 46, lines 35-43).

Ohnishi clearly teaches that the first server sends information request to other servers to retrieve the information of the destination output units (facsimiles) connected to the other servers.

It should be noted that the Examiner refers fig. 21 to provide a better description of the Ohnishi twelfth embodiment.

Also, according to Ohnishi, the servers 30, 31, and 32 can be read as both local and global servers since they all communicate with local output units as well as with other servers. It should be noted that the Office interprets the server 30 as a local server apparatus since it controls the local output units (printer 22 and facsimile 24) and

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the server 31 as a global server apparatus in a global network since it communicates with other servers for the information exchange (col. 27, lines 42-49).

However, Ohnishi does not disclose expressly if the network can be the Internet and if the controller is configured to transform image data, based on the obtained receiving facsimile unit information or capabilities regarding facsimile data that the receiving facsimile can receive, to convert the transformed image data into data for Internet transmission, and to transmit the converted data to the receiving facsimile.

Toyoda, on the other hand, discloses an image communication apparatus connected with a receiving facsimile via a server apparatus on the **Internet** (paragraph 12) wherein a controller is configured to obtain capabilities regarding facsimile data that the receiving facsimile can receive, to transform image data, based on the obtained receiving facsimile unit information or capabilities regarding facsimile data that the receiving facsimile can receive, to convert the transformed image data into data for Internet transmission (E-mail), and to transmit the converted data to the receiving facsimile (paragraphs 19 and 20).

Ohnishi and Toyoda are analogous art because they are from the same field of endeavor, which is the network facsimile art.

Since it was the Ohnishi objective to provide a server to collect information of output units over the network and Toyoda teaches the method of obtaining the capabilities regarding facsimile data that the receiving facsimile can receive and the method of transforming image data based on the obtained capabilities regarding facsimile data that the receiving facsimile can receive, it would have been obvious to

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one having ordinary skill in the art at the time the invention was made to combine the Toyoda system of transforming the image data with the network facsimile of Ohnishi.

The motivation for doing so would have been to inform the transmitting facsimile with the capabilities information of the receiving facsimile in advance so that the transmitting facsimile transmits proper transformed image data to the receiving facsimile that the receiving facsimile can receive in the Internet network.

Therefore, it would have been obvious to combine Ohnishi with Toyoda to obtain the invention as specified in claims 18.

11. With respect to claim 19, the combination of Ohnishi and Toyoda discloses the image communication apparatus according to claim 13, wherein Ohnishi further discloses the controller that stores, in the first server apparatus, the capabilities regarding facsimile data the receiving facsimile can receive, the capabilities being obtained from the second server apparatus (col. 44, lines 46-57). Upon receiving output unit information from the second server, the first server collects the information and updates it thus, storing the information or capabilities in the first server.

12. With respect to claim 20, the combination of Ohnishi and Toyoda discloses the image communication apparatus according to claim 13, wherein Ohnishi further discloses the capabilities of the receiving facsimile including one of resolution, a paper size, a compression format, and an encryption format that are utilized for a facsimile communication (col. 40, lines 52-54 & fig. 45(b)).

Toyoda also discloses that the capabilities of the receiving facsimile include one of resolution, a paper size, a compression format, and an encryption format that are utilized for a facsimile communication (paper size in paragraph 20).

13. With respect to claim 21, the combination of Ohnishi and Toyoda discloses the image communication apparatus according to claim 13, wherein Toyoda further discloses that the receiving facsimile is determined by the image communication apparatus (Email address).

14. With respect to claim 22, arguments analogous to those presented for claim 20, are applicable.

15. With respect to claim 23, arguments analogous to those presented for claim 20, are applicable.

16. With respect to claim 24, arguments analogous to those presented for claim 19, are applicable.

17. With respect to claim 25, arguments analogous to those presented for claims 18 and 24, are applicable.

18. With respect to claim 26, arguments analogous to those presented for claims 13 and 19, are applicable.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
August 16, 2004

Chan S. Park
Examiner
Art Unit 2622


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